

## **REMARKS**

Claims 16-25 were pending, examined and rejected in the December 31, 2002 Office action. No claims have been amended, deleted or added by this Response. Thus, claims 16-25 are now pending in this application. Applicant respectfully requests reconsideration of this application.

## **REJECTIONS UNDER 35 U.S.C. § 102**

Claims 16, 20, 21 and 23 stand rejected under 35 U.S.C. § 102(b) as being anticipated by the Siemens Servo Ventilator 300, as disclosed in the non-patent literature, Operating Manual for Siemens Servo Ventilator 300. Applicant respectfully traverses these rejections.

### **Claims 16-20**

Applicant's present claim 16 recites that the "inspiration valve is closed during expiration and the expiration valve is closed during inspiration." This limitation is not disclosed in the Siemens Servo Ventilator 300 references. At page 3 of the Office action, the Examiner incorrectly and without support asserts that the Siemens 300 inspiration valve is closed upon expiration and that the expiration valve is closed upon inspiration.

Furthermore, the Examiner's reliance on the disclosure at page 79 of the reference is misplaced. First, that section of the Siemens 300 manual merely discusses the ventilator's response to an error condition, namely that the upper pressure limit has been reached and that inspiration is stopped to "allow" for expiration. Nowhere does the

reference disclose that the inspiration valve is closed during expiration as claimed by Applicant. Second, the Examiner's statement that "it would have been inherent to close the expiration valve" is inappropriate as a matter of law. That such a feature may occur in the Siemens 300 is not sufficient to establish inherency. The Examiner has not carried its burden to show that such a feature necessarily flows from the teachings of the reference. See MPEP § 2112, pp. 2100-51 to 2100-53 (August 2001 ed.).

It is the Office's burden to show that each and every element of Applicant's claimed invention is found in the applied reference. Applicant respectfully submits that the Office has not carried its burden under § 102 and that the rejection should be withdrawn. Accordingly, Applicant respectfully submits that independent claim 16 and dependent claims 17-20 are patentable over the Siemens Servo Ventilator 300 reference.

### **Claims 21-23**

Applicant's present claim 21 recites that the pressure detector is operatively connected to the inspiratory branch and "disposed on said patient connection." The Siemens Servo Ventilator 300 reference does not disclose that the pressure detector is located on the patient connection, but as seen on page 16 of the Operating Manual, the pressure transducer 5 is located inside the machine. The Examiner has apparently overlooked this limitation to claim 21, which was added to the claim in the October 2, 2002 Amendment.

Applicant notes the Examiner's statement on page 9 of the Office action alleging that the location of the pressure detector is a mere design choice and that the device

would work equally well in other configurations. The statement was made without reference to any factual basis, nor is it well founded from a technical analysis. Such a statement overlooks the intricacies and nuances of such pressure measurements and control, and evidences a lack of understanding of the significance of Applicant's invention. Even if modifying the Siemens 300 ventilator with the disclosure of Weismann '352 did teach Applicant's claimed invention, which it would not, there is no teaching or even the faintest suggestion to combine the references. To support an obviousness rejection there must be some suggestion or motivation to modify a reference or combine reference teachings -- see MPEP § 706.02(j).

Accordingly, Applicant respectfully submits that independent claim 21 and dependent claims 22 and 23 are neither anticipated by nor obvious in view of the applied prior art. Applicant respectfully submits that the Office has not carried its burden under §§ 102 and 103 and that the rejections should be withdrawn.

### **REJECTIONS UNDER 35 U.S.C. § 103**

Claims 24 and 25 stand rejected under 35 U.S.C. § 103(a) as being anticipated by the Siemens Servo Ventilator 300, as disclosed in the non-patent literature, Operating Manual for Siemens Servo Ventilator 300, and in view of U.S. Pat. No. 5,647,351 (Weismann et al.). Applicant respectfully traverses these rejections.

The Examiner acknowledges that the non-patent literature regarding the Siemens 300 ventilator is silent concerning the pressure detector being disposed in the patient connection. However, this limitation is not found in Applicant's claim 24. Applicant's

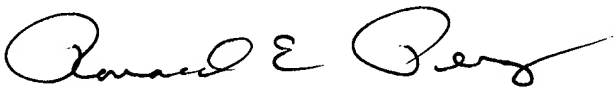
present claim 24 recites that the "inspiration valve is closed during expiration and the expiration valve is closed during inspiration." As discussed herein regarding claim 16, this limitation is not disclosed in the Siemens Servo Ventilator 300 references. Moreover, Weismann '351 does nothing to cure this deficiency. Thus, Applicant respectfully submits that the Examiner's rejection of claims 24 and 25 under § 103 is improper and should be withdrawn.

### CONCLUSION

In view of the foregoing, Applicant respectfully submits that claims 16-25 are in condition for allowance, and that the application should be passed to issue. The Examiner is encouraged to contact the undersigned should there be any questions or resolvable matters regarding this application.

Respectfully submitted,

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